

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

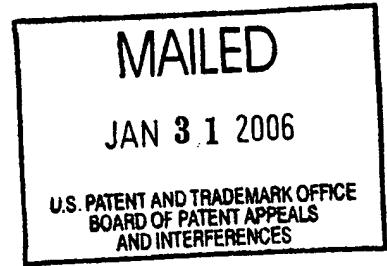
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANDERS R. WALLGREN, PRAVIN S. KOTHARI,
ELIZABETH A. CLEARY, PHILIP C. NELSON, and
BRETT E. BATTLES

Appeal No. 2005-2757
Application No. 09/328,983

HEARD: JANUARY 12, 2006



Before KRASS, DIXON, and BARRY, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-22, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

Appellants' invention relates to an iterative constraint collection scheme for preparation of custom manufacturing contracts. A copy of the representative claims under appeal are reproduced below.

1. A computer-based method, comprising comparing a plurality of vendor specific instances of an electronic print job request object within a combined view, each vendor specific instance of the print job request object to represent a relationship between a customer and one of a plurality of vendors to perform a print job project, each vendor specific instance of the print job request object defined through a series of iterative customer submissions and vendor responses to allow the customer to select one of the plurality of vendors to perform the print job project.
5. A computer system configured to allow a customer and a plurality of vendors to interact with one another in defining a plurality of vendor specific instances of an electronic print job request object for a print job project by permitting the customer to compare within a combined view, in an initially under-constrained fashion, each vendor specific instance of the print job request object and further permitting the vendors and the customer to successively develop each vendor specific instance of the print job request object to a fully-constrained form through an iterative process in which one or more constraints on one of the vendor specific instances of the print job request object are added, removed and/or modified during each iteration.
13. The computer-based vendor specific instance of the electronic print job request object of claim 12 wherein the print job project comprises a different pricing structure for each vendor based on at least bindings, covers, and delivery schedules.

Appeal No. 2005-2757
Application No. 09/328,983

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Huberman	5,826,244	Oct. 20, 1998
Farros et al. (Farros)	5,930,810	Jul. 27, 1999
Hill	5,970,471	Oct. 19, 1999 (Filed Mar. 22, 1996)
Thackston	6,295,513	Sep. 25, 2001 (Eff. Filing date Mar. 16, 1999)

Claims 1-12 and 14-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thackston in view of Hill and Huberman. Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Thackston in view of Hill and Huberman further in view of Farros.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed Apr. 19, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Feb. 5, 2004) for appellants' argument thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the

Appeal No. 2005-2757
Application No. 09/328,983

respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Only those arguments actually made by appellants have been considered in this decision. Arguments that appellants could have made but chose not to make in the brief have not been considered. We deem such argument to be waived by appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

At the outset, we note that appellants' representative withdrew Argument A at pages 5-6 of the Brief with respect to Thackston not being eligible as prior art. Therefore, we limit our review to appellants' Arguments B-E.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the

claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection.

See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Products Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art

would lead that individual to combine the relevant teachings of the references.” **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. We find that independent claim 1 recites “each vendor specific instance of the print job request object defined through a series of iterative customer submissions and vendor responses to allow the customer to select one of the plurality of vendors to perform the print job project.” The examiner maintains that the teachings of Thackston with respect to a negotiation process would have taught and fairly suggested the claimed iterative customer submissions and vendor responses, and the examiner has identified that appellants have not specifically defined the “iterative”

Appeal No. 2005-2757
Application No. 09/328,983

process in the specification. Furthermore, the examiner has supplied a definition of a “negotiation” as a means to further support the position that Thackston teaches an iterative process. (Answer at pages 5, 6, and 12-16.) We agree with the examiner that Thackston teaches a negotiation process which would have taught or fairly suggested a “series of iterative customer submissions and vendor responses” as recited in independent claim 1.

Appellants argue that there is “no suggestion/motivation to combine Thackston and Huberman with Hill.” (Brief at page 6.) We disagree and find that the examiner has set forth a statement of motivation at page 6 of the answer. Appellants argue that the merchandising of Hill is distinct and unrelated to the mechanism to collect bids from Thackston and Huberman. (Brief at page 6.) We disagree and do not find that appellants have shown error in the examiner’s rationale for the combination. Therefore, we do not find the argument persuasive. Similarly, we do not find the argument with respect to the combination of references with Farros persuasive for the same reason. (Brief at page 7.)

Appellants argue that the “series of iterative customer submissions and vendor responses” is not inherent in the negotiation process of Thackston. (Brief at pages 7-8.) Here, we find that the use of the word “inherent” seems to have misdirected appellants and the examiner has not used that terminology in the answer. Rather, the

examiner has provided a definition of the ordinary meaning of a “negotiation” as set forth in Thackston. (Answer at page 12-16.) While appellants argue that the “series of iterative customer submissions and vendor responses” is not “inherent” in the teachings of Thackston and appellants identify a situation where there may only be a single customer submission and a single vendor response so as to show that there is no “inherency,” we find no error in the examiner’s reliance upon the teachings of Thackston to teach or fairly suggest a “series of iterative customer submissions and vendor responses” as recited in the claims. Since the examiner’s rejection is based upon obviousness, we find no error besides a poor choice of wording in the responsive arguments in the final rejection that Thackston teaches an iterative process in the negotiation. The mere fact that either or both parties to the negotiation settle for a single iteration does not negate the teaching of a back and forth negotiation to clarify the terms and parameters of the goods and/or services. Therefore, we do not find the argument persuasive, and we will sustain the rejection of independent claim 1 and its dependent claims 2-4 which appellants have elected to group therewith. Similarly, we will sustain the rejection of independent claims 12 and 21 and their dependent claims 14 and 22 also grouped with independent claim 1.

With respect to dependent claim 5, appellants argue that the examiner fails to specifically address the element of independent claim 5 and that there is no indication

in Thackston that the constraints initially present in a template may be “removed and/or modified” as required by independent claim 5. (Brief at page 9.) We disagree with appellants and find that the examiner has addressed this limitation at pages 12-16 of the answer. Furthermore, we find that any modification of the template in the iterative process/negotiation would meet the “one or more constraints are . . . added, removed and/or modified during each iteration.” If there were no changes then there should not be any more iteration since the parties have a meeting of the minds and could then enter into a contract. Therefore, we do not find the argument persuasive, and we will sustain the rejection of independent claim 5 and independent claim 15 and dependent claims 6-11 and 16-20 which appellants have elected to group therewith.

With respect to dependent claim 13, appellants argue that while Farros does disclose that covers are a facet of the print product, there is no indication in Farros that the “pricing structure” may be based upon the cover. (Brief at pages 9-10.) While we agree with appellants that Farros does not expressly state that the cover is an element of the pricing structure, we agree with the examiner that it would have been obvious to one of ordinary skill in the art to have considered “covers” in the pricing structure since Farros teaches it is one of the characteristics of a print job that is of consideration in ordering a print job. Furthermore, it would have been obvious to one of ordinary skill in the art that if graphics or other costly setup were involved in printing a cover or if a wide range of materials were available for a more professional look and feel, these criteria

Appeal No. 2005-2757
Application No. 09/328,983

would have been considered in determining the price structure. Therefore, we do not find the argument persuasive and we will sustain the rejection of dependent claim 13.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-22 under 35 U.S.C. § 103 is AFFIRMED.

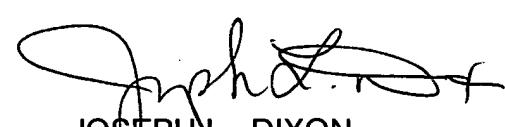
Appeal No. 2005-2757
Application No. 09/328,983

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a)(i)(iv).

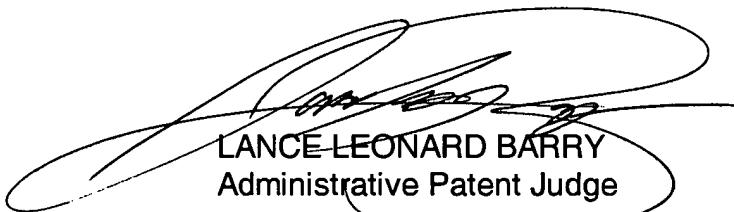
AFFIRMED


ERROL A. KRASS
Administrative Patent Judge

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BOARD OF PATENT
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JOSEPH L. DIXON
Administrative Patent Judge

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Administrative Patent Judge

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Appeal No. 2005-2757
Application No. 09/328,983

LAW OFFICE OF JAMES TROSINO
92 NATOMA STREET, SUITE 211
SAN FRANCISCO , CA 94105